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EXAMINER

LAUX, JESSICA L

ART UNIT PAPER NUMBER

3635

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/723,223

Applicant(s)

GLOCKL, JOSEF

Examiner

Jessica Laux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/02/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a floor construction, classified in class 52, subclass 582.1.
- II. Claims 23-24, drawn to a process of production of a floor construction, classified in class 52, subclass 745.13.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process that does not used a random generator and does not have a panel of EPP.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Myrun on March 16, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 23-24 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: element 15 is not shown in Figure 2 and the specification refers to element 15 on page 7, line 24.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show: (1) the sub-construction in the form of a mat with material fastened to the top, (2) the closed hollow internal space which is filled with a substance, (3) conductively connected vessels as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

The drawings are objected to because figures 4a-4d and 5-6 fail to have reference numbers and are not described in the specification in such a way as to enable one skilled in the art to understand them as they pertain to the invention.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

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is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: (1) the specification does not describe figures 4a-6 in such a way as to make them enabling to one of ordinary skill in the art, (2) the specification on page 7 line 18 refers to the surface portions as element 12 as well as elsewhere in the specification, on line 24 of page 7 the surface portions are referred to as element 15.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In line 3 applicant recites the limitation " with possible different

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properties", it is unclear whether applicant wants the one respective material to have different properties or not. In line 3 applicant recites the limitation "in particular properties...", it is unclear exactly what properties the applicant is requiring.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In lines 2 and 3 applicant recites the limitation "thus avoiding a unitary, externally homogeneous surface", it is unclear how a surface portion formed of the same material would avoid a unitary, externally homogeneous surface.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant recites the limitation, "tilting elements of the surface portions". There is insufficient antecedent basis for this limitation in the claim.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by "other materials". It should be noted that claim 14 is considered a product-by-process claim. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

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Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by "sealing means".

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by "or at least one of a predetermined viscosity or toughness".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 12-13, and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kupfer (4620816).

In regards to claim 1: Kupfer teaches a floor construction comprising: a plurality of surface portions (col. 4, lines 40-43), each comprising at least one respective material with possibly different properties, in particular properties in regard to human perception when standing on the surface portions, characterized in that different surface portions are of such an arrangement and configuration that when moving on the floor construction a continuously changing, unforeseeable sequence of different surface portions has to be unavoidably stepped on (Abstract).

In regards to claim 2: The floor construction according to claim 1 above, wherein the surface portions are each formed from the same material (Abstract, lines 15-17), thus avoiding a unitary, externally homogeneous surface, but that incorporated into the surface portions are identical or different inclusions cast therein so that when the surface portions are stepped upon overall different tactile stimuli are produced (Abstract, lines 17-19).

In regards to claim 3: The floor construction according to claim 1 above, wherein the surface portions represent portions of the floor construction that are separate from each other (Col. 4, lines 55-58).

In regards to claim 4: The floor construction according to claim 1 above, wherein the surface portions differ from each other in respect to at least one of shape and size (Col. 5, lines 5-8).

In regards to claim 5: The floor construction according to claim 1 above, wherein the properties comprise a degree of a surface roughness (Col. 4, lines 40-47).

In regards to claim 6: Kupfer teaches that it is known to have a walking surface with a plurality of surfaces with different properties that are stepped on as in claim 1 above. The surfaces would have different tactile properties such as a smooth concrete sidewalk (a solid material) with embedded pebbles or stones (a loose material) in a portion (col. 1, lines 43-53).

In regards to claim 12: The floor construction according to claim 1 above, further comprising an upper construction (element 18) that contains the surface portions and is supported by a sub-construction (element 20).

In regards to claim 13: The floor construction according to claim 12 above, wherein the sub-construction is a flexible material (col. 4, lines 37-39, wherein grass is flexible).

In regards to claim 15: The floor construction according to claim 1 above, wherein the floor construction can be used in at least one of inside and outside spaces (Col. 4, lines 26-39, where the walkway could be used inside or outside).

In regards to claim 16: The floor construction according to claim 1 above, wherein the floor construction is suitable for laying on conventional floor coverings (Col. 4, line 30).

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Doose (DE 4021958 A1).

In regards to claim 1: Doose teaches a floor construction comprising: a plurality of surface portions (element 1), each comprising at least one respective material (paving stones, Abstract line 13) with possibly different properties, in particular properties in regard to human perception when standing on the surface portions, characterized in that different surface portions are of such an arrangement and configuration that when moving on the floor construction a continuously changing, unforeseeable sequence of different surface portions has to be unavoidably stepped on (Abstract, lines 1-3, characterized in that the paving block with deflect when stepped on).

In regards to claim 7: The floor construction according to claim 1 above, wherein at least one of the surface portions and tilting elements of the surface portions are

movably mounted such that when a person steps thereon at least one of the surface portions and tilting elements changes position by tilting (Figure 6; Abstract, lines 1-3).

Claims 1, 9-11 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Streit et al (5542221).

In regards to claim 1: Streit et al. teaches a floor construction having a plurality of surface portions, each comprising a least one respective material (Col. 2 lines 27-29 and 60-61).

In regards to claim 9: Streit et al. teaches a floor construction as in claim 1 above, wherein at least one surface portion (element 3) further comprises a plurality of perpendicularly standing bar portions (element 4 and Col. 3, lines 61-63).

In regards to claim 10: Streit et al. teaches a floor construction as in claim 1 above, further comprising bar portions (element 4) having different degrees of stiffness (Col. 4, lines 65-end and Col. 5, lines 1-5).

In regards to claim 11: Streit et al. teaches a floor construction as in claim 1 above, further comprising groups of bar portions (element 4) having different degrees of stiffness (Col. 4, lines 65-end and Col. 5, lines 1-5) arranged in a surface portion (element 3 and col. 3, lines 61-63).

In regards to claim 17: Streit et al. teaches a floor construction as in claim 1 above, further comprising a sealing means (Col. 2, lines 60-66; Figure 5, elements 1 and 2) disposed between adjacent surface portions.

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In regards to claim 18: Streit et al. teaches a floor construction as in claim 1 above, wherein a transition between different surface portions is effected in an edge-free manner (Col. 2, lines 60-66).

Claims 1, 12, 14 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Donovan (4557475).

In regards to claim 1: Donovan teaches a floor construction having a plurality of surface portions (element 16, Col. 2, line 44), each comprising at least one respective material, wherein the floor construction is stepped on.

In regards to claim 12: Donovan teaches a floor construction as in claim 1 above, further comprising an upper construction (element 18) that contains the surface portions (element 16) and is supported by a sub-construction (element 32).

In regards to claim 14: Donovan teaches a floor construction as in claim 12 above, wherein the upper construction is foam (Col. 2, line 25) in which other materials are cast. The limitation "material are cast" is a method step and as such is not given much weight in an apparatus claim. Donovan teaches a floor construction that meets all of the structural limitations of the claim.

In regards to claim 22: Donovan teaches a floor construction as in claim 1 above, wherein the floor construction is capable of being used as a child's play mat. The limitation "use of the floor construction" is an intended use, as Donovans floor construction is capable of being used in such a way the claim limitations are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kupfer (4620816) in view of Hydock (10/087318).

In regards to claim 8: Kupfer teaches a floor construction as in claim 1 above, but does not teach that the surface portion comprises a heating or cooling means that heats or cools the surface. Hydock teaches a radiant heat flooring system that provides means for heating the surface of a floor construction (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the floor construction of Kupfer to have radiant heat as taught by Hydock as it would keep the feet of the walker on the surface warm in cold weather.

In regards to claim 19: Kupfer teaches a floor construction as in claim 1 above but does not teach the floor to have closed internal space filled with a liquid. Hydock teaches a floor construction having conduit within the floor panels to be filled with a liquid (paragraph 0091 and paragraph 0097, line 8 wherein antifreeze changes viscosity when it changes temperature).

In regards to claim 20: The floor construction according to claim 19 above, wherein the liquid substance is oil like (antifreeze is oil-like).

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In regards to claim 21: Kupfer teaches a floor construction as in claim 1 above, but does not teach the construction to have closed internal space in the surface portions connected in a mutually communicative relationship. Hydock teaches a radiant floor structure having conduit (21) within the floor panels (16) in a communicative relationship (paragraphs 0086 – 0088) and the filled with a material having a viscosity, wherein the fluid is water (paragraph 0097).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JL
03/16/2006



Naoto Slack
Primary Examiner